Serial No. 09/765,540
Filed: January 19, 2001

REMARKS/ARGUMENTS

In the Office Action, the Patent Office rejected claims 1 to 6, 8 to 12, and 15 to 18 under 35 U.S.C. § 103(a) as allegedly being unpatentable over United States Patent No. 5,389,546 (Becket) in view of United States Patent No. 5,667,760 (Sweeney) and "Potentiometric pH-stat titration", Experientia (Ballantyne); rejected claim 7 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Becket in view of Sweeney and Ballantyne and further in view of United States Patent No. 5,340,541 (Jackson); and rejected claims 13 and 14 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Becket in view of Sweeney and Ballantyne and further in view of United States Reissue Patent No. 28970 (Shapiro). These rejections are traversed for the reasons set forth below.

Applicants incorporate by reference their remarks made in their AMENDMENT dated August 10, 2004.

Applicants note that Becket is concerned with a continuous method for titration and in fact states that batch processes are not favorable (see column 5, line 15). Becket further states that the invention overcomes many of the "... disadvantages of the prior art non-titration and batch type titration methods ..." (see column 5, lines 18 to 23).

Furthermore, Becket states that "[m]ethods which remove a sample of the liquid from the central reservoir and perform analyses and/or measurements at a remote location (e.g. laboratory) are commonly termed off-line methods and inherently provide data that does not describe the current condition of the metalworking fluid because of the extended time involved in the sampling, transfer of sample to a remote location and the making of the analysis or measurements. Since the off-line methods do not provide an

accurate present condition picture of the metalworking liquid composition or condition the corrective measures indicated by such data and the measures taken themselves do not restore the liquid completely to the desired condition." (see column 6, lines 36 to 49).

The Patent Office is of the opinion that one of ordinary skill in the art would be motivated to combine Skoog with Becket since Skoog allegedly teaches advantages to weigh the mass of titrants rather than volume.

From the above, however, one skilled in the art would not be motivated to look to Skoog. As Becket has stated, "... batch type analysis are not favorable." (See column 5, line 15). Becket overcomes the disadvantages of batch type titration with a continuous process which uses the known flow rates of the metal working fluid to be analyzed and the titrants. See, for example, column 13, line 54 to column 14, line 9, where the flow rates of the acid titrant and the metal working fluid are used to calculate the total alkalinity. Volume amounts are used to provide a calibration chart, the data of which can be programmed into a computer or controller in Becket.

Skoog is deficient in identifying what kind of apparatus one skilled in the art might use in order to weigh components that would efficiently work with the apparatus of Becket. Indeed, just saying that "... weight titrations can now be performed more easily and more rapidly than volumetric titrations" (See Skoog, page 117), without more, does not provide enough information to one skilled in the art on how to modify Becket to allegedly render applicants' invention obvious. A document that gives only general guidance and is not specific as to the particular form of the claimed invention and how to achieve it cannot be used to render applicants' invention obvious. At best, it is speculation, obvious to try, and undue experimentation on the part of the skilled artisan to now determine how to modify Becket with Skoog to make applicants' invention. None of

these theories (speculation, obvious to try, and undue experimentation on the part of the skilled artisan) are a proper way for the Patent Office to render applicants' invention obvious.

Additionally, by weighing the titrants, in order to convert to determine the status of the liquid, Becket would have to determine the density of the metal working fluid. As Becket states, the metal working fluid is a complex mixture of materials and that it is important to monitor the physical and/or chemical conditions of the fluid on a frequent, preferably continuous basis (see, e.g., column 2, lines 53 to 55). While the Patent Office states that it would be easy to determine the density since the weight and volume are known, by using the weight 'advantages' of Skoog, the volume would not be known since, if it were more advantageous to use weight, why measure volume?

Becket further appreciates that "[i]n the absence of such real time analysis difficulty occurs in accurately adjusting the condition and/or composition of the metalworking fluid to original performance and condition standards. Several analysis and adjustments are often required when analysis data is obtained by a batch type method. These several analysis and adjustments are time consuming, costly and labor intensive." (See column 5, lines 7 to 14).

If one were to have to weigh titrants in Becket and find the density, the weight and density of the metal working fluid of Becket would only be representative at the time the sample was taken out of the bath, and not real time. "[O]ff-line methods do not provide an accurate present condition picture of the ... liquid." (Column 6, lines 44 to 49). So any data that Becket would determine for the metal working fluid would not represent real time, something that is important to Becket (see column 5, lines 21 to 22).

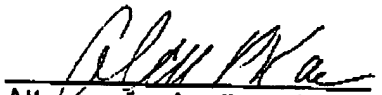
Serial No. 09/765,540
Filed: January 19, 2001

The rejections issued by the Patent Office all use Becket and Skoog. In view of the above, applicants have shown that one skilled in the art would not look to combine these documents to arrive at applicants' invention. As such, the remaining rejections of claims 7, 13, and 14, together with the rejection of claims 1 to 6 and 8 to 12 are traversed and withdrawal thereof is requested.

Applicants enclose a one (1) month extension of time.

Applicants submit that the concerns of the Patent Office have been addressed. Withdrawal of the rejections and issuance of a Notice of Allowance is respectfully solicited.

Respectfully submitted,



Attorney for Applicant(s)
Alan P. Kass
(Reg. No. 32142)
70 Meister Avenue
Somerville, New Jersey 08876
Telephone: (908) 595-3890
Telefax: (908) 429-3650

Customer No. 26,289